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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/529,588 04/17/00 MILLSTEIN

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023599 HM12/0702
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EXAMINER

PRASTHOFFER, T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

7/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/529,588

Applicant(s)

MILLSTEIN, LARRY S.

Examiner

Thomas W Prasthofer

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 8, 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 48-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Status of the Application

Receipt is acknowledged of an Information Disclosure Statement on March 26, 2001.

Status of the Claims

Claims 1-47 were cancelled and new claims 48-93 were added in Paper No. 4, received March 8, 2001. Claims 48-93 are subject to restriction and election of species requirements.

Remarks

It is noted that applicant added new claims by amendment but did not indicate where support for the newly added claims can be found in the disclosure.

Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 48-79, drawn to a method of making replicate arrays.

Group II, claim(s) 80-93, drawn to a wafer comprising a plurality of array members in an array.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and II do not share a special common

technical feature since arrays within the scope of the presently claimed invention are known in the art. See, for example, Battifora (1989) US Patent No. 4,820,504 and other X references cited in the international search report for PCT/US98/21860.

Because these inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1 for the reasons given above and

- a. have acquired a separate status in the art;
- b. have different and separately burdensome: manual and/or computer: structure, name and bibliographical searches; and
- c. have divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under CFR 1.17(h).

Election of Species

2. This application contains claims directed to patentably distinct species of the claimed invention. If applicant elects either of Inventions I or II, applicant is required to elect from the following patentably distinct species.

A) species of array members (i.e. atoms, proteins, peptides, nucleic acids, metals, ceramics, amino acids, nucleotides, saccharides, cells, tissues, cell extracts, prostaglandins, opiates, steroids, etc.)

B) species of structural members (i.e. hollow tubes or other specified configuration made of glass, plastic, ceramic, metal, etc.)

C) species of information embedded in each wafer (i.e. positional, lot no., contents of array, etc.)

D) species of disposition of array member (disposed on surface of lumen or completely filling the lumen)

E) species of analyte binding reagents (i.e. polynucleotides, polypeptides, polyamines, polyamides, antibodies, etc.)

The species are distinct, each from the other, because they have different chemical, physical, and/or biological properties and require different materials, conditions, and method steps for

their preparation. Therefore, different issues of enablement and patentability apply to each species and each species represents patentably distinct subject matter.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, *and a listing of all claims readable thereon, including any claims subsequently added*. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas Prasthofer** at telephone number **(703) 308-4548**. The examiner can normally be reached on Monday, Tuesday, Friday, and Saturday, 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Thomas Prasthofer, Ph.D.

June 28, 2001

BENNETT CELSA
PRIMARY EXAMINER

